UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,969	04/03/2001	Yoshinori Tanabe	1506.1006 (JDH)	9676

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EXAMINER
BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/823,969	TANABE, YOSHINORI
	Examiner	Art Unit
	William L. Bashore	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _03 April 2001_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-5_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-5_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: original application filed 4/30/2001, with priority filing

date of **9/21/2000**.

2.   Claims 1-5 are pending. Claims 1, 2, 3, 4, 5 are independent claims.

Specification

3.   The title of the invention is not descriptive. A new title is required that is clearly indicative of the

invention to which the claims are directed. The following title is suggested: Computer Readable Medium

Containing HTML Document Generation Program Utilizing Extended Tags.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   **Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to**

particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to independent claim 2, the phrase "*a second type*" extended tag is vague and indefinite,

since a second type implies a "first type", yet there is no indication of a first type within claim 2. It is noted that

although a "first type" is claimed in claim 1, each independent claim must "stand on its own", and not refer to

other independent claims for interpretation/clarification.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7.   **The claimed invention (as claimed in claim 4) is directed to non-statutory subject matter.**

In regard to independent claim 4, the combined limitations of claim 4 can be interpreted as a series of mental and/or manual steps (i.e. an HTML coded document can be "generated" (presented or outputted) manually via paper/pencil. In addition, reading and updating HTML elements (as claimed) can be accomplished mentally and/or manually).

The examiner's suggestion of changing the preamble of said claim to read *"A computer readable method..."* will serve to overcome this rejection.

For the purpose of rejection on the merits, the following rejections are based upon a possible interpretation of claim 4 as directed to a set of computer readable methods.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9.   **Claims 3, 4, 5 are rejected under 35 U.S.C. 102(b) as being patented/described by Davis et al. (hereinafter Davis), U.S. Patent No. 5,937,160 filed 5/1/1997, issued 8/10/1999.**

In regard to independent claim 3, Davis discloses an invention which creates/updates HTML documents via replacement of proprietary extended tags with data, said invention embodied on a medium (Davis Abstract, column 5 lines 25-33; compare with claim 3 *"a computer readable medium containing an HTML document generation program controlling a computer to execute:"*).

Davis discloses reading an HTML document containing a proprietary <RPM> type tag, said HTML document updated via the replacement of proprietary (i.e. extended) tags <RPM> (said tag type defining various processing, i.e. <RPMTD>, etc.) with data accordingly (Davis column 5 lines 1-7, column 10 lines 30-41, 64-66, column 11 lines 1-12, column 14 lines 65-67 to column 15 lines 1-44; compare with claim 3 *"a step of reading an HTML document incorporating an extended tag defining processing for updating an HTML document;"* and *"a step of updating said HTML document based on said processing defined by said extended tag included in the read HTML document;"*).

Davis discloses storage/presentation of a final HTML web page to a client via browser subsequent to updating (Davis Abstract, at bottom, also column 16 lines 61-67; compare with claim 3 *"a step of outputting the updated HTML document as an HTML document whose tags are all prescribed in HTML syntax."*).

In regard to independent claim 4, claim 4 reflects the computer readable instructions used for implementing the medium based program as claimed in claim 3, and is rejected along the same rationale.

In regard to independent claim 5, claim 5 reflects the computer readable instructions used for implementing the medium based program as claimed in claim 3, and in further view of the following, is rejected along the same rationale.

Davis discloses a computer (Davis Figure 1 items 10, 20).

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set

forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102
> of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the
> art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

11.   **Claims 1, 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis.**

In regard to independent claim 1, Davis teaches an invention which creates/updates HTML

documents via replacement of proprietary extended tags with data, said invention embodied on a medium (Davis

Abstract, column 5 lines 25-33; compare with claim 1 *"a computer readable medium containing an HTML*

document generation program controlling a computer to execute:").

Davis teaches reading an HTML document containing a proprietary <RPM> type tag, said HTML

document updated via the replacement of proprietary (i.e. extended) tags <RPM> (said tag type defining various

processing, i.e. <RPMTD>, etc., with said tags themselves not intended to be viewed in a browser) with data

accordingly (Davis column 5 lines 1-7, column 10 lines 30-41, 64-66, column 11 lines 1-12, column 14 lines 65-

67 to column 15 lines 1-44; compare with claim 1 *"a step of reading an HTML document including a first type*

extended tag which is defined so that said extended tag itself does not develop into a text;" and *"a step of*

recognizing said first type extended tag included in the read HTML document;").

Davis teaches the addition of an additional HTML (start and end) tag pair (controlling text bold

parameter <B> - a character style) wrapped around an RPM type tag, said tag pair bolding the text replacing

said RPM type tag (i.e. <B><RPMTD><B>) (Davis column 15 lines 20-29). Davis does not specifically teach

"ignoring" said HTML <B> tag pair. However, Davis teaches a user generating additions and/or revisions to the

content for updating (Davis column 8 lines 61-65). Since it is generally known in the word processing arts that

revisions to a document can embody additions, changes, and deletions, it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret document revisions to include deletions (i.e. leaving blank). Applying this to Davis results in an <RPM> tag replaced with blank space, therefore the <B> (bold) tags would be temporarily ignored since there would be no text to make bold (i.e. <B><RPM><B>) (see also Davis column 15 lines 22-28). Applying this interpretation provides Davis the benefit of leaving data portions blank for future use (i.e. if a customer has yet to obtain a cell phone, RPM text directed to a cell phone number can remain blank in the web page until the appropriate time, therefore preventing confusion).

Davis teaches storage/presentation of a final HTML web page to a client via browser subsequent to updating (Davis Abstract, at bottom, also column 16 lines 61-67; compare with claim 1 *"a step of generating an HTML document whose tags are all prescribed in HTML syntax, in accordance with specifications of said first type document extended tag included in the read HTML."*).

In regard to independent claim 2, claim 2 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.
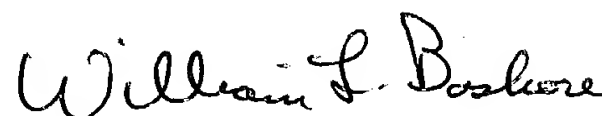
Davis does not specifically teach an RPM type tag as an extended tag "pair". However, since it is well known in the hypertext related arts that tags are generally defined in pairs, and that Davis teaches that a tag can be defined as "any unique set of keyboard symbols used to designate the location and control the placement of incoming page revisions and also to cause specific tasks to be executed." (Davis column 15 lines 27-33), it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret an RPM tag as a tag pair, providing Davis the benefit of nesting tag pairs around other data accordingly (compare with claim 2 *"... and said arbitrary text is enclosed by a predetermined identification extended tag pair"*.

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on 11:30am - 8:00pm EST. During the month of October 2004, the examiner's telephone number will transition to **(571) 272-4088.**

13.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. During the month of October 2004, the supervisor's telephone number will transition to **(571) 272-4090.**

14.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L. Bashore
Patent Examiner AU 2176
September 18, 2004